

### **REMARKS**

Claims 6 to 13 remain pending in the above-referenced application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph four (4) of the Office Action, claims 6 to 8, and 10 to 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Devore et al., U.S. Patent No. 3,821,703, in view of Banister et al., U.S. Patent No. 6,567,390.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 6, as presented, relates to a method for padding segments for transmitting data on a bus system, the segments having a preset total number of binary information pieces, the method including transmitting the data in the segments, and in the event of transmission of data including less binary information than a predetermined total number of the segments, padding the data to the total number of the segments by a filling pattern of a corresponding number of binary information pieces, in which the filling pattern includes a number of binary information pieces that corresponds to the total number of the segments and is first written into the segment, and in which the binary information of the data is subsequently written into the same segment, the particular binary information of the filling pattern being overwritten by the binary information of the data.

It is respectfully submitted that the Devore reference does not disclose or even suggest all of the claim features of claim 6, as presented. Indeed, the Office Action admits that "Devore does not disclose that padding data are first written into the segment, and

wherein the binary information of the data is subsequently written into the same segment, the particular binary information of the filling pattern being overwritten by the binary information of the data.” (Office Action, pp. 3 to 4). However, the Office Action attempts to cure this critical deficiency of the Devore reference by citing the Banister reference.

The Office Action conclusorily asserts that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the initialization of padding bits first, then overwriting with the actual data of Banister with Devore because it would help to enhance error control.” (Office Action, pp. 4, 6, and 7). Applicants respectfully submit that there is no suggestion or motivation to combine the Devore reference with the Banister reference as proposed in the Office Action, as there must be to reject claims as unpatentable.

In this regard, the Devore reference indicates that its central objective is to send complete data blocks with “enhanced error control.” (Devore, col. 2, line 38). Specifically, the Devore reference indicates a method to achieve this central objective by transmitting complete data blocks composed of full data segments and a residual segment, followed by an interblock gap to separate data blocks from one another. (Devore, col. 6, lines 13 to 21; and col. 8, line 53 to col. 10, line 2). Thus, the Devore reference suggests achieving its central objective by transmitting complete data blocks in this manner.

In stark contrast, the Banister reference states that its “overriding concern ... is to decrease energy consumption, thereby increasing mobile unit standby time.” (Banister, col. 7, lines 5 to 7). Specifically, the Banister reference refers to a method to achieve this overriding concern by receiving “less than all the encoded data in the frame and also [] less than all the encoded data representing the message.” (Banister, col. 7, lines 18 to 20). Thus, the Banister reference refers to achieving its overriding concern by “decod[ing] a message prior to receipt of a full frame of data,” to improve standby time and reduce power consumption. (Banister, col. 7, lines 29 to 40).

Accordingly, the Devore reference refers to the transmission of complete data blocks to enhance error control, whereas the Banister reference refers to the receipt of partial frames of data to reduce power consumption. Therefore, the Devore reference plainly teaches away from the proposed combination with the receipt of partial frames of data indicated by the Banister reference, and the Banister reference plainly teaches away from the proposed

combination with the transmission of complete data blocks indicated by the Devore reference. As such, there is no suggestion or motivation to make the proposed combination.

Moreover, it is respectfully submitted that the proposed modification would render the device described by each reference unsatisfactory for its intended purpose and/or change the principle of operation of the device described by each reference. As such, there is no motivation to make the proposed modification for this additional reason. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (there is no suggestion or motivation to make a proposed modification if the proposed modification would render the prior art device being modified unsatisfactory for its intended purpose); In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959) (the disclosures of references are not sufficient to render claims prima facie obvious if the proposed modification or combination would change the principle of operation of the prior art device being modified).

In this regard, the proposed modification of the Devore reference with the Banister reference would defeat the stated central purpose of the Devore reference, which is to transmit complete data blocks with enhanced error control. Further, the proposed modification of the Banister reference with the Devore reference would defeat the stated overriding concern of the Banister reference, which is to receive and decode partial frames of data, thereby reducing power consumption.

Simply put, there is no suggestion or motivation for making the proposed combination, as there must be for obviousness.

In light of the foregoing, it is respectfully submitted that the proposed combination of the Devore reference and the Banister reference (for which there is no suggestion or motivation to combine) does not disclose, or even suggest, all of the features of claim 6, and therefore, does not render unpatentable the presently pending claims for at least the foregoing reasons.

Claims 7 and 8 depend from claim 6, and are therefore allowable for at least the same reasons as claim 6.

Claims 10 and 12, as presented, include features like those of claim 6, and are therefore allowable over the proposed combination of the Devore reference and the Banister reference, for which there is no suggestion or motivation to combine, for at least the same reasons provided above.

Claims 11 and 13 respectively depend from claims 10 and 12 and are therefore allowable for at least the same reasons as their respective base claims.

With respect to paragraph five (5) of the Office Action, claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over Devore et al., in view of Banister et al., and further in view of Padovani et al., U.S. Patent Application Publication No. 2003/0063583.

As explained above with respect to claim 6, it is respectfully submitted that even if it were proper to modify the proposed combination of the Devore reference and the Banister reference, as suggested by the Office Action (which is not conceded), the secondary Padovani reference does not cure - and is not asserted to cure - the critical deficiencies of the proposed combination of the Devore reference and the Banister reference, for which there is no suggestion or motivation to combine.

Accordingly, claim 9, which depends from claim 6, is allowable over the proposed combination of the Devore reference and the Banister reference, for which there is no suggestion or motivation to combine, for essentially the same reasons explained above, since the Padovani reference does not cure - and is not asserted to cure - the critical deficiencies of the proposed combination of the Devore reference and the Banister reference.

As further regards all of the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing In re Dembiczak, 50 U.S.P.Q.2d 1614, 1618

(Fed. Cir. 1999) (obviousness rejections reversed where no findings were made "concerning the identification of the relevant art", the "level of ordinary skill in the art" or "the nature of the problem to be solved"))). It is respectfully submitted that there has been no such showings by the Office Actions to date.

In fact, the present lack of any of the required factual findings forces Applicants to resort to unwarranted speculation to ascertain exactly what facts underlie the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))).

In short, the Office bears the initial burden of presenting a proper prima facie unpatentability case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Withdrawal of these obviousness rejections is therefore respectfully requested.

In sum, it is respectfully submitted that claims 6 to 13 are allowable for at least the reasons provided above.

### Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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